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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/522,659	08/02/2005	Yuri Kurata	03723/0202265-US0	8715

7278 7590 04/05/2006

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EXAMINER

CRAIG, PAULA L

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 04/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No. 10/522,659	Applicant(s) KURATA ET AL.	
Examiner Paula L. Craig	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 January 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 January 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/13/05, 8/2/05</u> | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification fails to teach a fiber density of a fiber layer in the topsheet being higher at the side in contact with the skin of the wearer than at the side in contact with the absorption body (see Claim 2).

### ***Claim Objections***

2. Claim 6 is objected to because of the following informalities: For Claim 6, line 3, "feeing" should be "feeling". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-4 and 6 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. Having a first 1-max value of 1.1 kw/m<sup>2</sup> or less, and having the second q-max value be at least 0.5 kw/m<sup>2</sup> greater than the first q-max value,

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is critical or essential to the practice of the invention, but is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). Applicant indicates that nonwoven fabrics of 1 to 5 d fiber and perforated film are suitable for the invention (specification, page 10). However, the q-max values given for a topsheet having fibers of 2.2 d/ 1.9 d in Example 1 are not 1.1 kw/m<sup>2</sup> or less (see page 15). No examples are given in the specification of fibers or film types which have the claimed values.

6. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The meaning of the phrases "topsheet having a warm/cool feeling" and "warm/cool feeling of the topsheet" are unclear, as all topsheets have a warm and/or cool feeling, which may vary depending on environmental conditions.

### ***Claim Rejections - 35 USC § 102/103***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. Claims 1, 3, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over, U.S. Patent Application Publication No. 2002/0090875 A1 to Lasko et al.

11. For Claim 1, Lasko teaches a topsheet with liquid permeability of an absorbent article which has a warm/cool feeling (paragraph 1). The topsheet has a first q-max value at a side in contact with skin of a wearer of the topsheet, and a second q-max value at a side in contact with an absorption body (note that the two sides have different characteristics, paragraph 14 and Claim 6). Lasko teaches the topsheet fabric on the side in contact with the skin of the wearer being preferably 3 d or less (paragraph 14 and Claim 6). Lasko teaches the topsheet fabric on the side in contact with the absorption body having a higher denier than that of the side in contact with the skin of the wearer (paragraph 14 and Claim 6). Applicant's specification teaches that polyolefin-based fiber is suitable for the invention (page 10). Lasko teaches the use of polyolefin-based fiber (paragraph 17). Therefore, absent evidence to the contrary, the

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materials taught by Lasko are presumed to have Applicant's claimed q-max values when tested by the procedure described by Applicant. Applicant's claimed values are considered by the Examiner to be inherent in Lasko. *In re Schreiber*, 128 F.3d 1473, 44 USPQ2d 1429 (Fed. Cir. 1997); *In re Fitzgerald*, 619 F.2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138 (CCPA 1946).

12. For Claim 3, Lasko teaches a fineness of fiber layer that constitutes the topsheet being made lower at the side in contact with the skin of the wearer than at the side in contact with the absorption body (paragraph 14 and Claim 6).

13. For Claim 4, Lasko teaches an absorbent article including the topsheet of Claim 1, a liquid impermeable backsheet, and an absorbent core disposed between the topsheet and the backsheet. See Fig. 2 and paragraph 15.

14. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by, or in the alternative under 35 U.S.C. 103(a) as obvious over, U.S. Patent No. 4,761,322 to Raley.

15. For Claim 1, Raley teaches a topsheet with liquid permeability of an absorbent article which has a warm/cool feeling (inner liner 23, Figs. 1-5 and col. 1, lines 8-12). The topsheet has a first q-max value at a side in contact with skin of a wearer of the topsheet, and a second q-max value at a side in contact with an absorption body (note that the two sides have different characteristics, Figs. 1-5 and col. 7, line 52 to col. 9,

line 55). Raley teaches one side having a fibrous layer of lower density than the other side (col. 9, lines 53-60). Applicant's specification teaches that polyester-based fiber is suitable for the invention (page 10). Raley teaches the use of polyester-based fiber (col. 9, lines 40-44). Therefore, absent evidence to the contrary, the materials taught by Raley are presumed to have Applicant's claimed q-max values when tested by the procedure described by Applicant. Applicant's claimed values are considered by the Examiner to be inherent in Lasko. In addition, it has been held that the recitation that an element is "adapted to" perform a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense.

16. For Claim 2, Raley teaches the fiber density of the fiber layer that constitutes the topsheet being made higher at the side in contact with the skin of the wearer than at the side in contact with the absorption body (note the topsheet of Raley can be used with either side facing the wearer; see col. 9, lines 53-60, and col. 13, lines 20-34).

17. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Statutory Invention Registration No. H1969 H to Fell et al.

18. For Claim 5, Fell teaches a method for selecting and/or evaluating a sheet of an absorbent article with a favorable dry feeling (col. 36, lines 37-48). Fell teaches using a maximum heat transfer quantity to index a contact warm/cool feeling of a sheet of an absorbent article in a wet condition of the absorbent article (col. 36, line 26 to col. 37, line 12, and col. 38, lines 1-13). Fell teaches using the KES Thermo-labo test to determine the amount of heat transfer (col. 36, lines 26-59). The KES Thermo-labo test

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is also disclosed by Applicant as suitable for measuring q-max (specification, page 7).

Fell teaches that the ability of moisture and heat to permeate through fabric, as measured by the Thermo-labo test, is a significant factor in determining how comfortable a garment will be (col. 36, lines 38-49). Fell does not expressly teach using the method to select or evaluate a topsheet. However, it would have been obvious to one of ordinary skill in the art to modify Fell to use a test useful for measuring heat transfer in sheets of absorbent articles to measure heat transfer in a topsheet.

#### ***Allowable Subject Matter***

19. Claim 6 would be allowable if rewritten to overcome the rejections under 35 U.S.C. 112, 1<sup>st</sup> and 2nd paragraphs, set forth in this Office action. The closest prior art is Fell, Lasko and Raley. Fell teaches the use of q-max as a criterion for evaluating a sheet of an absorbent article, and also teaches a gradient for moisture permeability within the sheet. Lasko and Raley both teach a topsheet which has first and second q-max values, with the second q-max value being greater than the first q-max value. Neither Lasko nor Raley teach using the q-max value to index a contact warm/cool feeling of the topsheet in a wet condition of the absorbent article, nor using the q-max value as a criterion for selecting and/or evaluating a topsheet with a favorable dry feeling. There is insufficient motivation to combine Fell with Lasko or Raley.



**Conclusion**

20. The prior art references listed on the accompanying Form PTO-892 show the general state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paula L. Craig whose telephone number is (571)272-5964. The examiner can normally be reached on 8:30AM-5:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571)272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Paula L Craig  
Examiner  
Art Unit 3761

PLC

**TATYANA ZALUKAEVA**  
**PRIMARY EXAMINER**

